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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,068	08/22/2003	Louis C. Argenta	0101 P02977US1	9699

110 7590 12/21/2005

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EXAMINER	
PHILOGENE, PEDRO	

ART UNIT	PAPER NUMBER
3733	

DATE MAILED: 12/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/647,068	ARGENTA ET AL.	
	Examiner	Art Unit	
	Pedro Philogene	3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 September 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *10/31/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application No. 10/227,161. Although the conflicting claims are not identical, they are not patentably distinct from each other because it is clear that all the elements of claims 1-13 of the '161 application, are to be found in claims 1-13 of '161 application. The difference between these two sets of claims lies in the fact that the claims of the '068 application includes many more elements and is thus much more specific. Thus the invention of claims 1-13 of the '161 application is in effect a "species of the "generic" invention of claims 1-13 of the '068 application. It has been held that the generic invention is "anticipated" by the "species". See in re Goodman, 29 USPQ 2d 2010 (Fed. Cir. 1993). Since, claims 1-13 of the '068 application are anticipated by claims 1-13 of the '161 application, they are not patentably distinct from claims 1-13 of the '161 application.

Claims 1-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-45,96-103, 113-121 of copending Application No. 10/161,076 in view of Dunn et al. (5,717,030). Dunn et al teach a system that can be implanted anywhere in the body including bone, as best seen in column 5, lines 19-22. The system can be biodegradable and the active ingredient can include bone growth agents. Therefore, Dunn teach a bone substitute material that is bioabsorbable to promote bone growth. It would have been obvious to one having ordinary skill in the art to modify the copending claims to include bone substitute material at the wound to repair bone tissue. The copending claims already recite the treatment of repairing bone tissue. Dunn et al teach the details of the material that would provide the recited function.

Claims 1-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9-14,16-19,23-30,32,33,37-50,52-56,84-132 of copending Application No. 09/863,234 in view of Dunn et al. (5,717,030). Dunn et al teach a system that can be implanted anywhere in the body including bone, as best seen in column 5, lines 19-22. The system can be biodegradable and the active ingredient can include bone growth agents. Therefore, Dunn teach a bone substitute material that is bioabsorbable to promote bone growth. It would have been obvious to one having ordinary skill in the art to modify the copending claims to include bone substitute material at the wound to repair bone tissue. The copending claims already recite the treatment of repairing bone tissue. Dunn et al teach the details of the material that would provide the recited function.

Claims 1-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9-14,16-19,23-30,32,33,37-50,52-56,84-132 of copending Application No. 09/863,234 in view of Dunn et al. (5,717,030). Dunn et al teach a system that can be implanted anywhere in the body including bone, as best seen in column 5, lines 19-22. The system can be biodegradable and the active ingredient can include bone growth agents. Therefore, Dunn teach a bone substitute material that is bioabsorbable to promote bone growth. It would have been obvious to one having ordinary skill in the art to modify the copending claims to include bone substitute material at the wound to repair bone tissue. The copending claims already recite the treatment of repairing bone tissue. Dunn et al teach the details of the material that would provide the recited function.

Claims 1-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 38-41,43-46,71-80,83-86 of copending Application No. 09/026,353 in view of Dunn et al. (5,717,030). Dunn et al teach a system that can be implanted anywhere in the body including bone, as best seen in column 5, lines 19-22. The system can be biodegradable and the active ingredient can include bone growth agents. Therefore, Dunn teach a bone substitute material that is bioabsorbable to promote bone growth. It would have been obvious to one having ordinary skill in the art to modify the copending claims to include bone substitute material at the wound to repair bone tissue. The copending claims already recite the treatment of repairing bone tissue. Dunn et al teach the details of the material that would provide the recited function.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coffey (2001/0043943) in view of Dunn et al. (5,717,030).

With respect to claims 1-13, Coffey discloses a method for administering, applying, facilitating, treating and healing a reduced pressure treatment to a damaged tissue including a cover, a seal, open cell polymer foam, screen, vacuum suction port.

It is noted that Coffey teaches a substitute material to stabilize a wide variety of anatomical defects but doesn't recite use for hard tissue such as bone. However, in a similar art, Dunn et al evidences the use of a substitute that can be used any where in the body including hard tissue such as bone.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Coffey to use the substitute material for bone as taught by Dunn as an obvious equivalent alternative treatment as suggested by the prior art.

Response to Arguments

Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

2001/0043943	11-2001	Coffey
5,717,030	02-1998	Dunn et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pedro Philogene
December 14, 2005

PEDRO PHILOGENE
PRIMARY EXAMINER